

REMARKS

In the Office Action mailed August 26, 2004, the Examiner noted that claims 1-22 were pending and rejected claims 1-22. Claims 1, 2, and 18-22 have been amended and new claim 23 has been added. Thus, claims 1-23 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections and objection are traversed below.

Objection to the claims

The Examiner objected to claim 2. This reply amends claim 2 to address the issue raised by the Examiner.

Traversal of Official Notice

According to the Examiner,

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations (including the "Web page" elements and limitations) of claims 3-5, 7-11, 13-14 & 16 were well known and expected in the art by one of ordinary skill at the time of the invention.

Additionally, the Examiner asserts

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations claims 6, 12, 15 & 17 were well known and expected in the art by one or ordinary skill at the time of the invention.

Applicants traverse the Examiner's statements of Official Notice and request that the Examiner produce authority for the statements. Official Notice is only proper when the facts are "capable of such instant and unquestionable demonstration as to defy dispute" and "the facts so noticed are of notorious character and serve only to "fill in the gaps" that might exist in the evidentiary showing made by the examiner." MPEP § 2144.02(A). The features of claims 3-17 are specific to the advertising server of the claims and are not facts capable of such instant and unquestionable demonstration as to defy dispute. Furthermore, if the Examiner's assertions are correct, then producing authorities that disclose the facts should require little effort on the part of the Examiner.

Rejection based on U.S. Patent No. 5,724,521 ("Dedrick")

The Examiner rejected claims 1-22 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,724,521 ("Dedrick"). The Applicants respectfully traverse this rejection.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03.

As amended, claim 1 contains an "advertisement which is a second service provided as a privilege service pursuant to said first service providing contract." Dedrick does not teach or suggest this feature. Dedrick is directed to a system for providing customized advertising to users that does not provide any incentive features similar to this feature of claim 1. The feature of claim 1 provides a benefit that Dedrick does not provide. Specifically, this feature encourages a user to form a contract with the supplier of the first service.

Claims 2 and 18-21 are patentable over Dedrick for at least the same reasons that claim 1 is patentable over Dedrick.

New claim 23 contains the feature "displaying the advertisement only to the registered users as a privilege." This claim is patentable over Dedrick for at least the same reasons that claim 1 is patentable over Dedrick.

Claims 3-17 are patentable over Dedrick because they depend upon claim 1 and "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03.

Conclusion

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

Serial No. 10/001,992

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 11/19/4

By: 
J. Randall Beckers
Registration No. 30,358

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501